



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,852	05/26/2006	Fumito Takeuchi	1000023-000108	5655

21839 7590 03/11/2009
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
----------	--------------

1796

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

03/11/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/580,852	Applicant(s) TAKEUCHI ET AL.	
	Examiner ROBERT SELLERS	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 4-7,9,10,12,13,15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 11 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1796

1. The election with traverse of Group I in the non-Final rejection mailed October 16, 2008 is acknowledged. The traversal is on the ground that each of the claims of Groups II and III depend directly or indirectly from independent claim 1 of Group I. This is not found persuasive because the special technical feature of the blend of epoxy resin, (meth)acrylate monomer or oligomer and polythiol does not make a contribution over the prior art of Australian Patent No. 2003/264513 in view of Irving et al. and Slocki et al. as explained in the non-Final rejection. Claims 4 and 5 are withdrawn as being directed to the non-elected presence of the partially esterified epoxy resin (6).

The requirement is still deemed proper and is therefore made FINAL.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection.

Claims 1-3, 8, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Publication No. 2004/027502 as represented by Miyawaki et al. Publication No. 206/0009579 in view of Irving et al. Patent No. 4,836,878 and Slocki et al. Patent No. 4,383,090.

Art Unit: 1796

2. The Miyawaki et al. publication is not afforded the international publication date of equivalent PCT Publication No. 2004/027502 because the PCT publication was not published in English as required in MPEP § 706.02(f)(1), Example 5. However, the PCT publication is an equivalent of the Miyakawa et al. publication and its publication date of April 1, 2004 antedates the 371 date of the instant application of November 25, 2004.

Accordingly, the rejection is maintained for the reasons of record set forth in the non-Final rejection. The arguments filed February 17, 2009 have been considered but are unpersuasive.

3. The comparison between Example 1 and Comparative Example 1 in Table 2 on page 60 of the specification is inconclusive since any difference in results could be attributable to the absence of the partially esterified methacrylic acid-bisphenol F epoxy resin designated as ingredient (6) (described on page 59) as well as the absence of trimethylolpropane tris(3-mercaptopropionate designated as ingredient (5).

The evidence is not commensurate in scope with the claims regarding a representative sampling of the (meth)acrylic ester monomers or oligomers (2) embracing the myriad species listed on page 13 lines 2-15 as well as the diverse types of polythiols (5) disclosed on page 16, line 20 to page 20, line 21 throughout the claimed proportion range of from 0.001 to 5.0 phr.

Art Unit: 1796

4. The motivation of incorporating from 0.1% to 33% by weight of the mercaptan curing agent of Irving et al. into the composition of the PCT publication to increase the cure rate at lower temperatures as taught by Slocki et al. need not coincide with the believed function of the polythiol as a chain transfer agent. Note that nowhere in the description of the polythiol on pages 16-18 is there any characterization thereof as a chain transfer agent, which is merely a belief.

5. The incentive to incorporate the mercaptan curing agent of Irving et al. and Slocki et al. is not to replace the latent curing agent of the PCT publication, but to supplement it in order to increase the cure rate at lower temperatures (Slocki et al., col. 1, lines 43-45).

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Division 1796

rs
3/6/2009